Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFF D. WASHINGTON and PAUL F. AUSTIN

Appeal No. 1999-2615
Application No. 08/644,120

ON BRIEF

Before THOMAS, KRASS, and LALL, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 31-73, all of the pending claims.

The invention pertains to the editing of a control in a computer system. More particularly, the instant invention enables a user to see changes applied to an interface object before deciding whether to keep or discard the changes. A second internal control object is created in response to a user selecting a control for an editing

transaction and it is this second internal control object which is freely modifiable in place of the original internal control object. Thus, the user is permitted to see the results of proposed changes without actually changing the original internal control objects until and unless the user decides to make those changes.

Representative independent claim 31 is reproduced as follows:

> 31. A computer-implemented method for editing a control in a computer system, comprising:
>
> selecting said control for an editing transaction, wherein said control comprises a standard interface compliant control and a first internal control object;
>
> creating a second internal control object in response to said selecting said control for said editing transaction, wherein said second internal control object is a copy of said first internal control object;
>
> displaying said second internal control object after said creating said second internal control object;
>
> receiving first user input indicating a desired change to said control;
>
> changing said second internal control object in response to said receiving said first user input, wherein said changing produces a changed second internal control object;
>
> displaying said changed second internal control object;
>
> determining if said change is desired to be applied to said first internal control object in response to second user input;
>
> applying said change to said first internal control object if said change is desired to be applied to said first internal control object.

The examiner relies on the following references:

Li et al. (Li)	5,555,370	Sep. 10, 1996 (filed Dec. 28, 1993)
Cain et al. (Cain)	5,651,108	Jul. 22, 1997 (filed Jan. 11, 1996)

Claims 31-73 stand rejected under 35 U.S.C. § 103 as unpatentable over Cain in view of Li.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

At the outset, we note our decision in related Appeal No. 99-2641.

It is the examiner's position that Cain discloses the instant claimed subject matter but for applying a change to the first internal control object if the change is desired to be applied to the first internal control object. The examiner then turns to Li for such a teaching, identifying column 4, lines 3-29, and Figures 9 and 11 of Li. Finally, the examiner concludes that it would have been obvious to provide applying a change to the first internal control object if the change is desired in the Cain system "in order permitting a user to efficiently create an application utilizing a plurality of objects in a graphic user interface graphically presents objects to the user in the GUI and providing facility for cutting and pasting object while preserving any attach properties and methods" [sic] [answer-page 4].

We find that the examiner has failed to establish a prima facie case of

obviousness. The independent claims 31, 44, 53, 60 and 61 contain many elements yet the examiner merely alleges that these elements are present in Cain without specifically pointing out where such elements are found. For example, with regard to claim 31, the examiner alleges that all of the elements are disclosed in Cain except for the last "applying . . ." step. However, the only specific reference to Cain is to column 9, lines 5-67, and to Figures 4A-4F. The examiner does not specifically correlate the claimed elements to particular portions of column 9 of Cain.

We have reviewed the portion of Cain cited by the examiner and we find nothing therein about "creating a second internal control object in response to said selecting said control for said editing transaction, wherein said second internal control object is a copy of said first." If there is no creation of a second internal control object, then there can be no "displaying said second internal control object . . ." and there can be no "changing said second internal control object..." or "displaying said changed second internal control object," as claimed.

Moreover, even assuming, arguendo, that all of the claimed elements but for the last element in claim 31 are shown in Cain, the examiner has provided no convincing rationale establishing a motivation for making the proposed combination wherein anything taught by Li would have led the artisan to provide that teaching to the Cain system. The examiner's reasoning that the combination would have been made "in order permitting a user to efficiently create an application utilizing a plurality of objects

in a graphic user interface graphically presents objects to the user in the GUI and providing facility for cutting and pasting object while preserving any attach properties and methods" [sic] [answer-page 4] is not only so grammatically poor as to defy an accurate understanding of the examiner's position, but, to the extent that the examiner is implying that a "cut and paste" operation applied to the Cain system would improve or provide for anything, it is still unclear as to why any "cut and paste" property of Li, applied to Cain, would have resulted in the instant claimed subject matter.

Appellants argue [page 8-principal brief] that Cain discloses none of the elements recited in claim 31 except possibly "receiving first user input indicating a desired change to said control." In fact, referring to the portion of Cain cited by the examiner, appellants contend that Cain teaches nothing more than the prior art over which the instant claimed subject matter is an improvement and that the cited portion discloses only that objects are placed in forms and the object's properties are then edited through a pop-up menu and a property window. We agree. There is nothing in the cited portion of Cain, or any other portion of Cain, as far as we can tell, that suggests the claimed "second internal control object."

The examiner's response is that the instant claims are broad in nature and that the claimed requirement of a first internal control object and a second internal control object created in response to the selecting of a control for editing "can be interpreted as reading on Cain's computer-implemented method for editing a control in a computer

system in which the other property menu items in call up submenus when selected from which various properties, such as type and style, can be customized" [answer-page 6]. The examiner also appears to take the position that the claimed "second internal control object" may be met by Cain's disclosure of an object inheriting "a particular behavior as a result of its containership location" [answer-page 8].

We have carefully reviewed the examiner's rationale for the rejection and the examiner's responses to appellants' arguments but we are unconvinced by any of the arguments or the rationale that either of the applied references, or the combination, suggests the claimed "creating a second internal control object in response to said selecting said control for said editing transaction, wherein said second internal control object is a copy of said first internal control object."

Since each of the independent claims requires this limitation, we will not sustain the rejection of claims 31-73 under 35 U.S.C. § 103.

The examiner's decision is reversed.

REVERSED

JAMES D. THOMAS Administrative Patent Judge	)))))) BOARD OF PATENT) APPEALS) AND) INTERFERENCES)))
ERROL A. KRASS Administrative Patent Judge	
PARSHOTAM S. LALL Administrative Patent Judge	

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